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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,367	07/18/2003	Klaus Abraham-Fuchs	32860-000578/us	4057
7590	12/20/2007			
Alexander Burke, Esq. SIEMENS CORPORATION Intellectual Property Department 170 Wood Avenue South Iselin, NJ 08830			EXAMINER	
			WONG, LUT	
			ART UNIT	PAPER NUMBER
			2129	
			MAIL DATE	DELIVERY MODE
			12/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/621,367	ABRAHAM-FUCHS, KLAUS
	Examiner Lut Wong	Art Unit 2129

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 September 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-35 and 37-53 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-35 and 37-53 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

This office action is responsive to an AMENDMENT entered Sept 26, 2007 for the patent application 10/621367.

The First Office Action of Jan 09, 2007 is fully incorporated into this Final Office Action by reference.

### ***Status of Claims***

Claims 1-35, 37-53 are pending. Claims 1, 7-9, 13-15, 17-18, 24-29, 32, 37-38, 41-42, 47 have been amended. Claim 36 are cancelled.

### ***Response to Arguments***

In re pgs. 14-16 of argument filed May 05, 2007, applicant's amendment have been fully considered and have overcome the objections of drawing, title , specification, and claims 1, 8, 9, 13, 14, 17, 29, 32, 37, 38, 41, 42. The objections have been withdrawn.

In re pg. 16 of argument filed May 05, 2007, applicant's amendment have been fully considered and have overcome the 112 second paragraph rejection of claims 1-16, 24-41, 47. The rejections have been withdrawn.

In re pg. 18 of argument filed May 05, 2007, applicant's argument have been fully considered and persuasive. The 112 first paragraph rejection claims 16, 4, 40, 41, 35 have been withdrawn.

### ***Claim Rejections - 35 USC § 101***

Claims 1-35, 37-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, as set forth in the previous office action for reason of record.

***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

In re pgs. 16-17, applicant argues that practical application was disclosed in the spec (5:9-10).

In response, that practical application is not recite in the claim. EN: The claims and only the claims form the metes and bounds of the invention. Limitations appearing in the specification but not recited in the claim are not read into the claim. There is no mention of these limitations in the claims and the specification is not the measure of the invention.

In re pg. 17, applicant argues that the evaluation result outputted by the evaluation module is useful, tangible.

In response, the claim merely says "outputting an evaluation result". If the output is presented to a user, then it can be useful and tangible. However, if the output is to something else, such as software modules or interface, then the result are still abstract. In that case, the result is not tangible.

In re pg. 17, applicant argues that the evaluation module may be implemented as hardware which is statutory subject matter.

In response, [0024] of applicant's disclosure also defines the evaluation module may be implemented as software. A claim that is so broad that it reads on both statutory and non-statutory subject matter must be amended.

***Claim Rejections - 35 USC § 102***

Claims 1-35, 37-53 are rejected under 35 U.S.C. 102(b) as being anticipated by NCR, as set forth in the previous office action for reason of record.

***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

In general, applicant is reminded that Examiner has full latitude to interpret each claim in the broadest reasonable sense. Furthermore, applicant fails to define many important terms, which gives the Examiner even more latitude to interpret claim limitations.

In re pg. 20, applicant argues that NCR does not teach the amended limitation of

*"internally descrambling the scrambled data, evaluating the descrambled data in accordance with at least one expert rule associated with the selected evaluation option, and outputting an evaluation result derived from said internally descrambled data"*

*using the evaluation module, without making the descrambled data directly accessible to the user”*

Because NCR provides a user with direct access to the data permitted by the system through dataview.

In response, the Examiner disagrees. Using the broadest reasonable interpretation, NCR reads on the claim. The data are not "directly accessible" to the user simply because the user has to access the data through dataview module.

In re pgs. 20-21, applicant further argues that NCR does not teach the amended limitation of

*"outputting an evaluation result derived from said internally descramble data "*

Because the evaluation result is NOT the data itself and thus is not equivalent to the privacy parameter controlled dataview of NCR.

In response, the Examiner disagrees. The claim only recites "outputting an evaluation result derived from said internally descrambled data". Nowhere in the claim exclude the data itself being an evaluation result. The data outputted to the dataview are derived from said internally descrambled data.

In re pg. 21, applicant argues NCR provides no 35 USC 112 compliant enabling disclosure of a method able to perform the activities claimed in amended claim 1, therefore not anticipated by NCR.

In response, the Examiner disagrees. Applicant seems to forget that the Examiner is obligated to interpret each claim in the broadest reasonable sense. NCR reads on all the claim limitations simply because the claim scope is way too broad that covers NCR's teaching. Hence, NCR does provide an enabling disclosure.

In re pg. 21, applicant argues that NCR fails to disclose  
*"the algorithm produces the key as a function of at least one of an input and of a biometric feature of the authorized person"*  
as recited in claim 3 because [0058] of NCR merely describes encryption techniques that are used on an identified field, which is wholly unrelated to producing a key for descrambling data.

In response, the Examiner disagrees. It is inherent nature, and well known in the art, that an input (such as password or codes) must be received in order to encrypt/decrypt (See the Microsoft Dictionary pg. 192 on encryption and encryption key). Hence, when NCR disclosed encryption techniques, it inherently disclose the decryption was a function of an input.

In re pg. 22, applicant argues that NCR fails to disclose  
*"the sensitive data is scrambled immediately after its recording, so that it is not accessible in unscrambled form on a data storage medium"*  
as recited in claim 4 because [0057] of NCR merely describes the use of data encryption.

In response, the Examiner disagrees.

1) The use of encryption clearly reads on the claim. Once the data are encrypted, it is not accessible (See the Microsoft Dictionary pg. 192 on encryption).

2) Furthermore, EN: ¶2 applies. The terms "scrambled", "unscrambled", "accessible" are not defined. Broadly speaking, any data not readable by a user is "scrambled"; and readable data is "unscrambled". Hence, any data in the system of NCR not displayed is considered "*scrambled immediately after its recording, that it is not accessible in unscrambled form on a data storage medium*"

In re pg. 22, applicant argues that NCR fails to disclose "*the at least one of inhibiting and enabling of the at least one predetermined evaluation options in the evaluation module is permitted only after the authorized person has entered a predetermined user identification*"

as recited in claim 7 because NCR merely describes the providing access to the database after verifying identity, such that it is wholly unlike the present claimed invention which provides .

In response, the Examiner disagrees. The claim limitation of "*the at least one of inhibiting and enabling of the at least one predetermined evaluation options in the evaluation module*" is merely a setting/option/parameter within the module. The claim limitation of "*is permitted only after the authorized person has entered a predetermined user identification*" is merely user authentication. The

whole claim is drawn to providing data/setting/parameter access after authentication. How is it different from the providing access to the database after verifying identity in NCR?! Applicant is reminded that limitations in the specification are not read into the claim.

In re pg. 23, applicant argues that NCR fails to disclose  
*“the evaluation options are selected using the associated expert rules such that they do not allow any conclusion to be drawn from the evaluation result relating to individual sensitive data items without entering authorized access verification.”*

as recited in claim 15 because as argued above that NCR provides direct access to the database.

In response, the Examiner disagrees. See the response to claim 1 above. Also, all data are accessible only after the user has gain access to the database. And the user cannot “directly access the data” because all the access has to access through a dataview module.

In re pg. 24, applicant argues that NCR fails to disclose claim 19 for the same reason as claim 3.

In response, the Examiner disagrees. See the response to claim 3 above.

In re pgs. 19-26, applicant either argues NCR does not provide 112 enabling disclosure for the dependent claims, or the dependent claims are at least allowable the reason as independent claim is allowable.

In response, see the response above. All the independent claims are remain rejected and NCR does provide enabling disclosure. All the claimed limitations are anticipated by NCR.

***Claim Rejections - 35 USC § 103***

Claims (11, 26, 39, 51), (12, 27, 40, 52), (13, 28, 41, 53), (14, 29) are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over NCR in view of Microsoft computer dictionary.

**Claims (11, 26, 39, 51), (12, 27, 40, 52), (13, 28, 41, 53):** NCR anticipates a server (See [0021]). It is inherent properties of a server to have a storage medium. *EN: it is non functional distinct whether the medium is a common or a separate or a portable data storage medium.* Even if NCR does not anticipates that the scrambled data and the evaluation module are stored on a common or separate or portable data storage medium. It would still have been obvious to one of ordinary skill in the art that a server is capable of storing in any kind of storage medium. (See pg. 474 of Microsoft computer dictionary on “server” regarding network resource such as disk drive).

**Claims 14, 29:** NCR anticipates customer preferences (See e.g. [0021]).

The preference must be presented in the forms of questions. *EN: it is non functional distinct whether the options are in the forms of questions or not.* Even if NCR does not anticipates that the evaluation options are in the forms of questions. It would still have been obvious to one of ordinary skill in the art that preference can be asked in question form. (See pg. 417 of Microsoft computer dictionary on “preferences” that preference is a menu choice. EN: the choice must be a question and answer form).

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

In general, applicant only argues the rejection under 103(a). Applicant did not argue the rejection under 102(b). Hence, the rejection under 102(b) is maintained. The arguments for the 103 are addressed below.

In re pg. 27, applicant again argues that NCR provides direct access. Thus, there is no motivation to combine. Even if it is combined, it would still not produce the present claimed invention.

In response, the Examiner disagrees.

1) Applicant seems to forgot the claim limitation in claims (11, 26, 39, 51), (12, 27, 40, 52), (13, 28, 41, 53), are directed to storage medium. Applicant's

arguments are not related to the claims (11, 26, 39, 51), (12, 27, 40, 52), (13, 28, 41, 53). Nevertheless, see the response above in regarding the arguments of direct access.

In re pg. 28, applicant challenges the Official Notice because “server having a storage medium” and “preference in the form of question” are not “wide notoriety” nor “instant and unquestionable demonstration”.

In response, the Examiner disagrees. One of ordinary skill or even no skill in the art would clearly see “server having a storage medium” and “preference in the form of question” are well known. Nevertheless, see the rejection above.

### Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lut Wong whose telephone number is (571) 270-1123. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent David can be reached on (571) 272-3080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lut Wong/  
Patent Examiner, AU 2129

  
DAVID VINCENT  
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